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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/820,648 | 03/30/2001 | David W. Cannell | 5725.0843-00 | 3537 |
| 22852 | 7590 | 08/08/2005 | | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | EXAMINER VENKAT, JYOTHSNA A | |
| | | | ART UNIT 1615 | PAPER NUMBER |
| DATE MAILED: 08/08/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,648

Applicant(s)

CANNELL ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-167 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 19-21, 30-63, 80-101, 118-135, 139-141, 150 and 152-167 is/are rejected.
- 7) ☒ Claim(s) 67-69, 78, 79, 105-107, 116 and 117 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-30-01
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 16-18,22-29,64-66,70-77,102-104,108-115,136-138,142-149 and 151.

DETAILED ACTION

Receipt is acknowledged of election and IDS filed on 5/24/05 and 3/30/01 respectively.

Election/Restrictions

1. Applicant's election with traverse of group II in the reply filed on 5/24/05 is acknowledged. The traversal is on the ground(s) that that the Examiner has not shown that examining Groups I and II-VI together would constitute a serious burden and the classified five of the six groups II-VI in the same class and subclass as group I. This is not found persuasive because even though all the groups are related to monosaccharides it is a search burden to examine all the groups since the saccharides are not structurally similar and additionally the search in non-patent literature for all these groups is also a search burden.
2. The requirement is still deemed proper and is therefore made FINAL
3. Claims 16-18, 22-29, 64-66, 70-77, 102-104, 108-115, 136-138, 142-149 and 151 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/24/05.

Claims 1-15, 19-21, 30-63, 67-69, 78-101, 105-107, 116-135, 139-141, 150 and 152-167 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

4. The information disclosure statement filed 3/30/01 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because applicants did not explain the relevance of the documents identified as 12-15 and 19-20 cited on PTO -1449. The documents 12-15 are drawn to NPL and it is not in English and the documents 19-20 cite various abstracts, which are not

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cited separately on 1449. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

5. The co-pending applications, which are crossed-out have been considered, but they will not be listed for printing. The foreign patents have been crossed-out since applicants provided only abstracts and these abstracts are cited on 1449.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-15, 32-63, 80-101, 118-135 and 152-167 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description.**

8. Applicants are notified that the written description is based upon the expression claimed in claims 12, 60, 76, 98 and 132 and the expression “polymers comprising glycoproteins amino group” claimed in claims 15, 63, 101 and 135.

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To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to

A composition for durable non-permanent shaping of least one keratinous fiber or durable retention of a non-permanent shape of least one keratinous fiber comprising :

1. (a) at least one compound comprising at least one C5 to C7 saccharide unit substituted with at least one amino group, and

(b) at least one film forming agent, wherein said at least one compound and said at least one film forming agent are present in an amount effective to impart a durable non-permanent shape to said at least one keratinous fiber or to durably retain a non-permanent shape of said at least one keratinous fiber

and the dependent claim 12 recites:

A composition according to claim 1, wherein said at least one C5 to C7 saccharide unit is further substituted with at least one group different from said at least one amino group.

and part of dependent claim 15 recites:

A composition to claim 1, wherein said at least one compound is chosen from polymers comprising at least one C5 monosaccharide substituted with at least one amino group, polymers comprising at least one C6 monosaccharide substituted with at least one amino group, polymers comprising at least one C7 monosaccharide substituted with at least one amino group, and glycoproteins comprising at least one C5 to C7 saccharide unit substituted with at least one amino group.

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The specification does not define substituents with at least one group different from said at least one amino group. The same is true for all the polymers recited in claim 15.

The expressions claimed does not convey to one of ordinary skill in the art that applicants were in possession of the claimed subject matter. Claims employing language at the point of novelty, such as applicants', neither provide those elements required to practice the inventions, nor "inform the public" during the life of the patent of the limits of the monopoly asserted. The expression could encompass myriad of compounds for which there is no description to even one single polymer or one substituent.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-15, 32-63, 80-101, 118-135 and 152-167 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expressions "polymers comprising at least one C5 monosaccharide substituted with at least one amino group, polymers comprising at least one C6 monosaccharide substituted with at least one amino group, polymers comprising at least one C7 monosaccharide substituted with at least one amino group, and glycoproteins comprising at least one C5 to C7 saccharide unit substituted with at least one amino group and substituents with at least one group different from said at least one amino group" are without metes and bounds. Recourse to the specification describes the language claimed but not the specific compounds and substituents.

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Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1,4,9-11,14-15,19-21,30,32-43,130-131,134-135,139-141,150 and 152-163 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 5,141,964 ('964) as evidenced by Skin Care and Cosmetic Ingredient Dictionary, page 114 (1994).

The dictionary is used to show that that chitosan disclosed in the example is the film forming agent and the dictionary discloses that this compound forms film on the skin.

See examples 1 and 5-9. See col.1, lines 54-65 for glucosamine which is the claimed and elected hexosamine, chitosan is the film forming agent and gluconic acid is the additional sugar which is monosaccharide. The intended use does not carry patentable weight as the claims are drawn to the compositions.

DETAILED ACTION

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-15, 30-43, 130-135, 139-141, 150, and 152-167 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents '964 and 4,240, 450 ('450) and 5,866,142 ('142).

The patent '964 does not disclose the specific film forming agents claimed or the limitation claimed in claims 12. However patent '450 teaches the specific film forming agents claimed in the instant application in the compositions. See the abstract, see col.1, lines 10-15, see col.2, line 29 et seq, see col.s 3-43 for the various cationic polymers and their preparation, see col.43, lines 25 et seq for the anionic polymers, see examples. See claim 20 for claiming two compositions, which are packaged in different containers and claims 164-167 are drawn to kit with two compartments. Patent '142 teaches the limitation of claim 12 and this compound is N. acetyl D-glucosamine. See the abstract and see col.3, lines 5-35, see clo.7 and see claim 7 and 31.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '964 and use specific film forming agents of '450 expecting beneficial effect. One of ordinary skill in the art would be motivated to combine glucosamine with the specific film forming agents like cationic polymer or anionic polymer with the reasonable expectation of success that the polymers can be retained on the hair and these

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polymers are useful in various hair care art. One of ordinary skill in the art would be motivated to use N-acetyl- glucosamine for glucosamine in the compositions of '964 with the reasonable expectation of success that this compound provides hyaluronic acid whcih provide hydration results. The kit is also obvious since it is easy for the consumer to pack ingredients in two different containers. This is a prima facie case of obviousness.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims drawn to compositions are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims drawn to compositions and which overlap with the claimed hexosamines of copending Application No. 09/820,858 and 09/820,648. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap of subject matter drawn to compositions, which has the same hexosamines.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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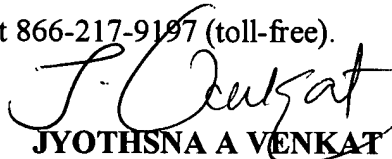
Allowable Subject Matter

18. Claims 67-69, 78-79, 105-107 and 116-117 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615
